

## **RESPONSE**

This is a response to the Final Office Action dated December 21, 2005. The Examiner has rejected claims 1-4, 6-9 and 11-17 under 35 U.S.C. § 103(a) as being unpatentable over: U.S. Pub 2001/0034676 (“Vasic”) in view of U.S. Pub 2005/0160051 (“Johnson”). In addition, claims 5 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vasic in view of Johnson and further in view of U.S. Pub 2002/0004772 (“Templeton”).

The rejections from the Final Office Action of December 21, 2005 are discussed below. No new matter has been added. Reconsideration of the application is respectfully requested in light of the above amendments and the following remarks.

### **I. REJECTIONS UNDER 35 U.S.C. § 103(a)**

Claims 1-4, 6-9 and 11-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vasic in view of Johnson. Applicants submit that claims 1-4, 6-9 and 11-17 are patentable over Vasic in view of Johnson because the combination of Vasic and Johnson fails to disclose all the limitations of the claims and further that one of ordinary skill in the art would not be motivated to combine these references.

Vasic discloses a “payroll access program allowing an employee to request access to payroll through a third party.” Vasic, Abstract. Johnson discloses “methods of, and systems for, allowing an account participant to add value via a wide-area network to a first account form a second account.” Johnson, Abstract.

Vasic fails to disclose the step of “verifying with the account access information whether the first user has access to the bank account.” Vasic does disclose providing a master bank account with sub-accounts for transferring funds. Vasic, ¶ 56. Vasic discloses how to set-up a sub-account for transferring data with a master bank account. Vasic, ¶¶ 56-57. “The sub-account actually has no funds until the sub-account is activated by using the card and the funds are automatically transferred from the master account or alternatively transferred or wired with associated fees.” Vasic, ¶ 56. However, in Vasic, the transfers are “automatic” and do not require the verification step as disclosed in claims 1 and 16. Johnson also fails to disclose “verifying with the account access information whether the first user has access to the bank account.”

As noted by the Examiner, Vasic fails to disclose establishing a second online account as in claims 1 and 16. The Examiner suggests this is disclosed in Johnson in the abstract and in paragraph 47. Johnson does not have 47 paragraphs, but only has 40 paragraphs. Applicants believe that Johnson also fails to disclose “receiving a response from the recipient, wherein the response includes a request to establish a second online account for the recipient; [and] establishing a second online account associated with the recipient” as in claims 1 and 16.

While, Johnson does disclose a transfer from a first account to a second account (Johnson, Abstract), Johnson further discloses that a user receives information to identify a second account. *Id.* at FIG. 3; ¶¶ 26, 34. Accordingly, there is no disclosure of receiving a response, which includes a request to establish a second online account as in claims 1 and 16. The system in Johnson has a second account with no discussion of a response from a recipient with a request for its establishment or creation. Apparently, the second account is pre-existing because there is no suggestion of its creation. Specifically, Johnson fails to disclose a response with a request to create a second account, and further fails to disclose establishment of the second account. Johnson merely discloses a request for a transfer of funds to the second account. *Id.* Claims 1 and 16 include a response with a request to create a second account and further disclose the establishment of the second account.

Not only does Johnson fail to disclose establishing a second account, it further fails to disclose “establishing one or more sub-accounts linked to the first online account, wherein for transactions involving each sub-account, actual funds are transferred between the bank account and the first online account” as in claims 1 and 16. As discussed above, Johnson does not disclose the establishment of any accounts, let alone a second account, or any sub-accounts. Johnson merely discloses a transfer between multiple accounts, but no requests for establishment or creation of accounts. *See* Johnson, FIG. 3; ¶¶ 26, 34.

In addition, one of ordinary skill in the art would not be motivated to combine the Vasic and Johnson references. In order to make a case of prima facie obviousness, any motivation to modify the prior art references must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed Cir. 1995); *In re Gorman*, 933 F.2d 982, 986-87, 18 USPQ2d 1885, 1888, (Fed. Cir. 1991). There is no specific suggestion, explicit or implicit, to combine the teachings of Vasic and Johnson.

The motivation provided by the Examiner to combine the teachings of the references is that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Vasic et al’s to include Johnson’s concept of receiving a response included [sic] a request for establish [sic] an [sic] first online account for the recipient and establishing a second online account for the recipient....” However, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *Para-Ordnance Mfg. v. SGS Importers Int’l*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). Moreover, a reason must be supplied to specifically combine the teachings of Vasic and Johnson as “[s]ubstantially all inventions are the combination of old elements; what counts is the selection out of all their possible permutations, of that new combination which will be serviceable.” *Safety Car Heating and Lighting Co. v. General Elec. Co.*, 155 F.2d, 937, 939 (2d Cir, 1946).

Specifically, there is no motivation to use Johnson to add a “request to establish a second online account for the recipient” to Vasic. In fact, such a combination is opposite to the objectives of Vasic. Vasic relates to the setting up of sub-accounts for employees with limited access to a master payroll account. Vasic, ¶¶ 18-21. Vasic teaches away from allowing an employee to request a second online account for transferring funds from the master payroll account. The purpose of Vasic is to set up sub-accounts that have limited access to the master payroll account. Vasic, ¶¶ 18-21. The limited access means that the employee’s would not be allowed to create a second online account to transfer funds from the master payroll account.

For the reasons described above, Applicant submits that independent claims 1 and 16 are allowable. Likewise, claims dependent from allowable claims 1 and 16 are also allowable. Claims 5 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vasic in view of Johnson and further in view of Templeton. Claims 5 and 10 depend from claim 1, which is allowable as discussed above. For the same reasons that claim 1 is allowable, Applicants believe claims 5 and 10 in addition to all other dependent claims are also allowable. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

**CONCLUSION**

Each of the rejections in the Final Office Action dated December 21, 2005 has been addressed and no new matter has been added. Applicants submit that all of the pending claims are in condition for allowance and notice to this effect is respectfully requested. The Examiner is invited to call the undersigned if it would expedite the prosecution of this application.

Respectfully submitted,

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Date

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